



02.21-06

JFW

Attorney Docket No.: 14489-009001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert H. Mimlitch, et al. Art Unit : 3634
Serial No. : 10/622,402 Examiner : Jennifer E. Novosad
Filed : July 18, 2003
Title : SLIDING RACK-MOUNTABLE SHELF FOR RACK-MOUNTABLE
COMPONENTS

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed January 17, 2006, Applicant provisionally elects claims 24, 3, 5, 13, 14, and 25-38 in Group I should the requirement for restriction be maintained. It is noted that this provisional election is identical to the provisional election filed October 31, 2005. With respect to the newly presented species requirement, Applicant provisionally elects the species of Figures 5, 6A, and 6B and the sub-species of Figure 8. Applicant submits that all pending claims are readable on the provisionally elected species and sub-species in that none of the claims include limitations that preclude the claim from reading on the provisionally elected species and sub-species.

The requirement for restriction is respectfully traversed.

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. 802.01, headed "Meaning of 'Independent' and 'Distinct'" reads, in relevant part, as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EV 708556031 US2/17/2006
Date of Deposit

which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT. M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

Clearly, search and examination of the entire application can be made without serious burden because prior art related to the support shelf in Group I must be searched in connection with examining the slidable support for a support shelf in Group II and the method for supporting a load in a rack system in Group III. In addition, while there are nineteen (19) claims in Group I, there are only four (4) claims in Group II, and only one (1) claim in Group III.

The Examiner's assertion that the claims in Groups I and II are related as subcombinations usable together in a single combination, and that the claims in Group III are related to the claims in Groups I and II as product and process of use, has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden. That the inventions are related precludes a ruling that the groups are independent and distinct.

In this case, search and examination of the entire application can be made without serious burden because prior art related to the claims in Group I is likely to disclose subject matter that must be searched in connection with examining claims in each of the related groups. In particular, the independent claims in Groups II and III recite limitations that are recited in the claims of Group I. For example, claims 26 and 39 (from Groups I and II, respectively) recite a center slide member coupled to (or adapted for coupling to) a base and operable to translate relative to the base and an outer slide member coupled to (or adapted for coupling to) the center slide member and operable to translate relative to the center slide member. Accordingly, prior

Applicant : Robert H. Mimlitch, et al.
Serial No. : 10/622,402
Filed : July 18, 2003
Page : 3 of 3

Attorney's Docket No.: 14489-009001

art related to claim 26 is likely to disclose subject matter that must be searched in connection with examining claim 39, and vice versa. Similarly, claims 26 and 43 (from Groups I and III, respectively) recite limitations that involve a center slide member coupled to a base and operable to translate relative to the base and an outer slide member coupled to the center slide member and operable to translate relative to the center slide member. Thus, prior art related to claim 26 is likely to disclose subject matter that must be searched in connection with examining claim 43, and vice versa. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn.

No fee is believed to be due at this time. However, if Applicant is incorrect, please apply any deficiencies or any other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,



Spencer C. Patterson
Reg. No. 43,849

Date: 2/17/06

PTO Customer No. 26231
Fish & Richardson P.C.
1717 Main Street
Suite 5000
Dallas, Texas 75201
Telephone: (214) 292-4082
Facsimile: (214) 747-2091

90160196.doc